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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,906	12/13/2000	Daniel R. Michelson	207950	8383

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EXAMINER

SAADAT, CAMERON

ART UNIT PAPER NUMBER

3713

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/736,906

Applicant(s)

MICHELSON ET AL.

Examiner

Cameron Saadat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-6, 8-13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amtex Corporation (EP 0782338A2).

4. Referring to claims 1, 3, 9, 10, 12, and 18, Amtex Corporation discloses a karaoke system and method comprising a video image capturing device for processing a video image of a karaoke performer; a karaoke medium player for retrieving audio signals and using an audio processor to provide an output audio signal; an indicia image of a song from a karaoke medium; indicia control means 18 and indicia position detection 50a (see Figure 17); video image control means 30 that provides an electronic circuit for downscaling and repositioning (column 4, lines 4-5); means for superimposing an indicia image on the image of the karaoke performer and

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providing an output video image; a video monitor for displaying the composite output video image (column 11, lines 14-36).

5. Referring to claims 1, 3-6, 8-13, 15-16, and 18-20, Amtex Corporation teaches all the features of the claimed subject matter except those directed towards downscaling the indicia image. Amtex Corporation does not specifically teach that the indicia control means provides a downscaling feature, however does teach the downscaling feature with regards to the video image control means (column 4, lines 4-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the indicia control means as taught by Amtex Corporation to provide the same downscaling features used in the video image control so that the indicia image does not overlap and conceal the image of the karaoke performer, thereby allowing the performer to easily read the lyrics in the indicia image and view the image of him/her self simultaneously.

6. Referring to claim 2, Amtex Corporation discloses a karaoke system wherein the indicia image contains words 20 for the song (column 11, line 33).

7. Referring to claims 4, 11, 13, and 19 Amtex Corporation discloses a karaoke system and image processing device wherein the means for compositing utilizes a circuit that removes the background of the repositioned indicia image before overlaying it on the image of the karaoke performer (column 11, lines 23-26).

8. Referring to claim 5, Amtex Corporation discloses a karaoke system wherein the means for downscaling and compositing are implemented in a stand-alone device separate from the karaoke medium player (see Figure 22, ref 30).

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9. Referring to claim 6, Amtex Corporation discloses a karaoke system wherein the means for downscaling and compositing are implemented as components of the karaoke medium player (see Figure 19, ref 30).

10. Referring to claims 8 and 20, Amtex Corporation discloses a karaoke system with the means for downscaling an image but does not specifically teach that the indicia image is downscaled vertically by selectively dropping lines of the indicia image. However, it is the examiner's position that such features are inherent to scaling and old and well know in the art. Such features of scaling are provided so that the indicia image does not overlap and conceal the image of the karaoke performer, allowing the performer to easily read the lyrics.

11. Referring to claim 16, Amtex corporation discloses a karaoke system wherein the video processing circuit 4 includes a subcode processor 18 for receiving a stream of subcode data retrieved from the karaoke medium representing the indicia image and modifying the subcode data to effect the repositioning with the indicia image control 50a (see Figure 17).

12. Claims 7, 14, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amtex Corporation (EP 0782338A2) in view of Kim (U.S. Patent No. 5,506,690).

13. Referring to claims 7 and 14, Amtex Corporation discloses a karaoke medium player but does not specify a compact-disk-plus-graphics (CD+G) disk. However, Kim teaches the use of a compact-disk-plus-graphics disk for a karaoke medium player (column 1, lines 18-20). In view of Kim, It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the karaoke medium player of Amtex Corporation so that it utilizes a compact-disk-graphics disk because such a disk is capable of storing video and audio information, including

song text information, which is necessary for a karaoke medium player. Furthermore, using such devices as compact-disk-graphics disks or laser disks for the purpose of a karaoke medium player is old and well known in the art.

14. Referring to claims 15 and 17, Amtex Corporation discloses a karaoke medium player wherein the video processing circuit superimposes a repositioned indicia image with an external video image and video processing circuit 4 also includes a subcode processor 18 which sends the modified subcode data to a microprocessor 50a (see Figure 17). However, Kim teaches a video processing circuit that includes a compact-disk-plus-graphics disk and decoder (column 1, lines 18-20). In view of Kim, It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the video processing circuit of Amtex Corporation so that it utilizes a compact-disk-graphics disk because such a disk is capable of storing video and audio information, including song text information that can be easily extracted with a video processing circuit. Furthermore, using such devices as compact-disk-graphics disks or laser disks for the purpose of a karaoke medium player is old and well known in the art.

### *Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Ito et al. (U.S. Patent No. 5,151,793) – Recording Medium Playing Apparatus
- Choi et al. (U.S. Patent No. 5,726,373) – Video-song Accompaniment Apparatus Using a Compact Disk as a Recording Medium

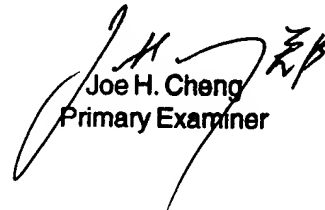
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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS  
June 10, 2002

  
Joe H. Cheng  
Primary Examiner